

REMARKS

After entry of the foregoing amendments, claims 1-4, 6-13, 18 and 19 are pending in this application. New claims 18 and 19 are added via this Amendment. Claims 5 and 14-17 are cancelled. Claims 1-3 and 10-13 are withdrawn. The Examiner rejected claims 1-4 and 6-17. As an initial matter, Applicants respectfully point out that box 6 of the Office Action Summary should correctly read claims "4-9 and 14-17" are rejected.

35 U.S.C. §112:

The Examiner rejects claims 4 and 6-9 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite. In particular, the Examiner asserts that independent claim 4 is indefinite because it recites, *inter alia*:

“wherein the chamfered portions of the outer peripheral surface of the paster roller which are opposed to portions in the range of 20 mm to 50 mm from both end portions of a web, which contact the outer peripheral surface of the paster roller, in a width direction.”

The Examiner questions what portions are being opposed to the outer peripheral surface of the chamfered portions. The Examiner also asks what the end portions of the web are and what a width direction is.

Claim 4 is hereby amended to recite that the paster roller is configured such that when a web is placed in contact with the roller, side portions of the web extend over each of the chamfered portions by an amount in the range from 20 mm to 50 mm. Applicants respectfully submit that one skilled in the art would be apprised of the scope of claim 4, and request that the rejection

thereof be withdrawn. Claim 4 is amended only for clarification of language, and not because of prior art.

35 U.S.C. §103:

Claims 4, 6 and 14

Claims 4, 6 and 14 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over GB 2,030,968 A (hereinafter “GB ‘968”). Applicants traverse the rejection in view of the following remarks.

The Examiner newly applies GB ‘968 and asserts that a roller 10 is disclosed as having chamfered portions 12 formed at both end portions of an outer peripheral surface thereof. The Examiner further alleges that 1) portions of a web W’ are aligned across from the outer peripheral surface of the chamfered portions 12 and both edges of the web extend from edges of straight portions 11, 14 of the roller; and 2) a width of the web contacts the outer peripheral surface of the roller 10, as shown in Figs. 2-3.

The Examiner acknowledges that GB ‘968 fails to disclose the recited range of claim 4. Thus, the Examiner alleges that it would have obvious to one of ordinary skill in the art to select a certain range to meet the features of claim 4. Applicants again respectfully traverse the Examiner’s position.

Applicants reemphasize the arguments presented in the previous response by respectfully submitting that GB '968 does not make obvious the features of claim 4 regarding the claimed range of 20 mm to 50 mm because it is settled law that a particular parameter first must be recognized as a result-effective variable before the determination of the optimum or workable ranges of the variable can be characterized as routine experimentation. (See MPEP §2144.05(II)(B).) In the present case, GB '968 does not even address the distance that the web W' extends over the tapered end 12, let alone that such distance is important in achieving some desired result, and could not have recognized that such a distance is a result-effective variable. Accordingly, Applicants respectfully submit that the rejection should not stand because GB '968 could not have provided any motivation for deriving the features of claim 4 and, likewise, dependent claim 6.

Moreover, it appears that the Examiner is borrowing the asserted obviousness language from MPEP §2144.05(II)(A) entitled "Optimization of Ranges." However, Applicants respectfully point out that the case¹ that supports this assertion describes optimization of concentrations and temperatures - none of which is presently recited. Instead, claim 4 describes the physical configuration of a structure. Thus, Applicants respectfully submit that for this additional reason, the Examiner's rejection should not stand.

¹ *In re Aller*, 220 F.2d 454 (CCPA 1955).

The Examiner has allegedly set forth a new ground of rejection, but has applied the same standard (i.e., discovering optimum or workable ranges, etc). However, the grounds of rejection do not address Applicants' previous assertions that the features of claim 4 were not recognized as being a result-effective variable. Thus, Applicants respectfully submit that a complete response to the previous Amendment, as required by §707.07(f), has not been presented. In particular, this section of the MPEP requires that "in order to provide a complete application file history and to enhance the clarity of the prosecution history record, an examiner must provide clear explanations of all actions taken by the examiner during prosecution of an application." (Emphasis added.) Furthermore, this section requires that "where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." (Emphasis added.)

In the present case, the Examiner is attempting to apply the exact same standard, but has not answered the substance of Applicants' prior response because the Examiner has not set forth support for his alleged contention that the features of claim 4 are recognized as being a result-effective variable. Therefore, Applicants respectfully submit that the Examiner's response is improper and that the rejection of claim 4 should be withdrawn. The rejection of claim 6 should also be withdrawn at least due to claim 6 depending from claim 4. The rejection of claim 14 is rendered moot by the cancellation thereof.

Claims 7-9 and 15-17

Claims 7-9 and 15-17 are rejected under 35 U.S.C. §103(a) as being unpatentable over GB '968 in view of Carlson (U.S. Patent No. 4,756,065). Applicants traverse the rejection in view of the following remarks.

The Examiner relies on GB '968 for the features of independent claim 4. Applicants submit that claims 7-9 are patentable over the references at least by virtue of them depending from claim 4 because Carlson fails to cure the deficiencies in the teachings of GB '968. Thus, the combination of the applied references would not have taught or suggested the claimed features. The rejection of claims 15-17 is deemed moot due to these claims being cancelled.

Further, the Examiner acknowledges that the applied references fail to disclose the range of hardness of claim 9. Accordingly, the Examiner again makes a basic statement of obviousness regarding "discovering the optimum or workable ranges." Applicants respectfully direct the Examiner's attention to the arguments presented hereinabove in regard to claim 4 because the references fail to teach or suggest that the hardness aspect is a result-effective variable.

NEW CLAIMS:

The elected species covers Figures 4 and 5. Thus, to obtain more varied protection for the invention, Applicants add dependent claims 18 and 19 that further define the chamfered portions as being curved. Inasmuch as GB '968 shows the alleged chamfered portions as having a flat surface; not one that is curved, Applicants respectfully submit that new claims 18 and 19 are patentable over GB '968.

AMENDMENT UNDER 37 C.F.R. §1.111
U.S. SERIAL NO. 10/079,857

ART UNIT 3654
Q68660

In view of the preceding amendments and remarks, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue that the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the local telephone number listed below.

The USPTO is directed and authorized to charge all required fees (except the Issue/Publication Fees) to our Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

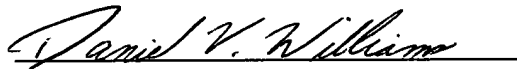
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Date: June 10, 2004